

15. DNA coding for the enzymes according to Claim 14 comprising SEQ ID NO: 11.

16. Cosmid clones comprising an isolated DNA according to Claim 15.

Please add new claim 20.

20. DNA coding for the enzymes according to Claim 14 comprising SEQ ID NO: 15.

<b>REMARKS</b>
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Claims 14 and 16 have been amended and new claim 20 has been added. Claims 14-20 are now pending. It is believed that no new matter has been added.

***Comments about Information Disclosure Statement***

The examiner stated he did not consider EP 583 687 A2; EP 761 817 A2; and WO 94/02621 because no translations were provided for the references. However, this is an improper basis for not considering the references. MPEP 609 states:

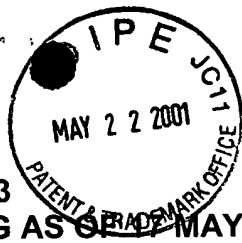
"The Office has set forth the minimum requirements for information to be considered in 37 CFR 1.97 and 37 CFR 1.98. Once the minimum requirements are met, ***the examiner has an obligation to consider the information.***"

With regard to references written in a foreign language, MPEP 609 A(2) states:

"Translation are not required to be filed unless they have been reduced to writing and are actually translations of what is contained in the non-English language information. ***If no translation is submitted, the examiner will consider the information in view of he concise explanation and insofar as it is understood on its face***, e.g., drawings, chemical formulas, English language abstracts, in the same manner that non-English language information in Office search files is considered by examiners in conducting searches."

Additionally, MPEP 609 A(3) states:

USPN: 08/976,063  
CLAIMS PENDING AS OF MAY 2001:



Bayer 9998.1-HCL  
HR 161-US Mn/Cr

**COPY OF CLAIMS SHOWING AMENDMENTS TO THE CLAIMS**

14. An isolated eugenol hydroxylase comprising two subunits wherein one subunit comprises [1] a cytochrome C which is encoded by SEQ ID NO: 11 and wherein the second subunit comprises a flavoprotein which is encoded by SEQ ID NO: 15.
15. DNA coding for the enzymes according to Claim 14 comprising SEQ ID NO: 11 **[and 15]**.
16. Cosmid clones comprising an isolated DNA according to Claim 15.
17. Vectors comprising DNA according to Claim 15.
18. Microorganism transformed with the DNA according to Claim 15.
19. A process of converting eugenol to coniferyl alcohol comprising subjecting eugenol to the eugenol hydroxylase according to claim 14 for a period of time sufficient to convert the eugenol to coniferyl alcohol and recovering the alcohol thus formed.
20. DNA coding for the enzymes according to Claim 14 comprising SEQ ID NO: 15.

"Each information disclosure statement must further include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent, publication, or other information listed that is not in the English language. The concise explanation may be either separate from the specification or incorporated therein."

The applicants have provided a concise explanation for the three references not previously considered (see page 7 of the Information Disclosure Statement of 12/28/2000) and as such have met the minimum requirements set forth by the PTO for consideration (An unsigned copy of the IDS listing the three references in question has been attached to the office action.)

***Response to Claim Objections/Rejections***

It is believed that the claim amendments address all of the examiner's objections and rejections and the claims are now in condition for allowance. If any further questions arise, please do not hesitate to call the applicants' representative at the phone number below.

Respectfully submitted,  
NORRIS McLAUGHLIN & MARCUS, P.A.

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HCL:ja

Attachments: Copy of IDS listing three unconsidered references  
Copy of claims as amended

**CONDITIONAL PETITION FOR EXTENSION OF TIME**

If entry and consideration of the amendments above requires an extension of time, Applicants respectfully request that this be considered a petition therefor. The Assistant Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

**ADDITIONAL FEE**

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

**CERTIFICATE OF MAILING**

I hereby certify that the foregoing Petition for Extension of Time is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Hon. Commissioner of Patents, Washington, D.C. 20231, on the date indicated below:

Date:

By Howard C. Lee  
Howard C. Lee